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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 09/914,866   | 10/09/2001  | Michael Roreger      | F-7104                       | 4132             |
| 28107  | 7590        | 12/30/2003           |                              |                  |
| JORDAN AND HAMBURG LLP<br>122 EAST 42ND STREET<br>SUITE 4000<br>NEW YORK, NY 10168 |             |                      | EXAMINER<br>LORENZO, JERRY A |                  |
|  |             |                      | ART UNIT<br>1734             | PAPER NUMBER     |

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/914,866

Applicant(s)

ROREGER ET AL.

Examiner

Jerry A. Lorengo

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-15,17 and 18 is/are rejected.
- 7) ☒ Claim(s) 3 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

(1)

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4, 6, 8, 9, 10, 11, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2132740 to Senninger in view of U.S. Patent No. 5,368,943 to Baghdachi et al.

Regarding applicant claim 1, Senninger discloses a process for producing an article having an active substance comprising the steps of:

- (1) Providing a first and second base material layers having identical composition, i.e., polymer material (page 1, column 2, lines 113-119);

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(2) Providing an active substance as a flowable medium (page 1, column 2, line 122 to page 3, column 1, line 60);

(3) Applying the active substance onto either one or both of the base material layers (page 1, column, lines 106-112); and

(4) Placing the first and second base material in contact with the coated active material disposed therebetween and bonding (irreversibly joining) the layers together (page 1, column 2, lines 79-81).

Senninger, however, does not specifically disclose the active substance viscosity, coating pressure or storage step of applicant claim 1. Senninger, however, discloses that the active substance in flowable form may comprise a polyurethane resin intermixed with an ethylacetate solvent (page 1, column 2, lines 88-105). It would have therefore been obvious to one of ordinary skill in the art at the time of invention that the active agent liquid utilized by Senninger would have a viscosity of at least 1000mPs (1cP) motivated by the fact that Bagdachi et al., drawn to polyurethane polymer compositions disclose that polyurethane intermixed with an ethylacetate solvent has a viscosity of 100 to 500 cP (column 3, lines 41-57)

Furthermore, the metering pressure set forth in applicant claim 1 (of less than 12 bar - 174 psi), would have been obvious to one of ordinary skill in the art at the time of invention motivated by the fact that Senninger disclose that the active substance may be applied by spraying, printing or any suitable method (page 1, column 2, lines 106-12) which the skilled artisan would appreciate could occur at standard atmospheric pressure, i.e., 14psi.

Finally, with regards to applicant claim 1, although Senninger discloses that the first and second base material layers are identical in that they are both polymer materials (page 1, column 2, lines 113-119), he does not specifically disclose that they are identical in composition. It would have been obvious to one of ordinary skill in the art at the time of invention, however, to modify the method of Senninger to utilize base material layers which are identical in composition motivated by the fact that such use would simplify the methodology by reducing material cost and also provide homogenous material properties and equivalent diffusion of the active material through the base material layers.

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Although Senninger does not disclose the storage step of claim 1 or the storage parameters of applicant claims 4 and 17, one of ordinary skill in the art at the time of invention would have been appreciative of the fact that the material could be stored at such temperature and for such a duration motivated by the fact that Senninger discloses that the active substance laminate may have a storage life of 6 months at standard temperature and pressure whereby the active substance would diffuse through the permeable base material layers to form an essentially homogenous matrix (page 2, column 1, lines 27-33; page 3, column 2, lines 109-111).

Regarding applicant claim 6, Senninger disclose that the active substance may be intermixed with a property-altering agent such as piperonyl butoxide, a synergist (page 1, column 1, lines 46-63).

Regarding applicant claim 8 and 11, Senninger discloses that the active substance may be intermixed with a bonding agent to render it self-adhesive (page 1, column 2, lines 96-99).

Regarding applicant claim 9, Senninger discloses that the active substance may comprise pyrethrum, a volatile substance (page 1, column 2, lines 64-75).

Regarding applicant claim 10, Senninger discloses that the first and second base material may comprise ethylene vinyl acetate (page 1, column 2, lines 113-19).

Regarding applicant claim 13, Seninger disclose that one of the base material layer may be preliminarily provides with an active substance prior to formation of the laminate (page 1, column 2, lines 106-112).

(2)

Claims 7, 12, 14, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references combined in section (1), above, in further view of U.S. Patent No. 4,693,393 to Von Kohorn et al.

Although Senninger, as combined in section (1), above, discloses that the active substance may be applied by spraying, printing or any suitable method (page 1, column 2, lines 106-12), he does not specifically disclose, as per applicant claims 7, 15 and 18, that its is applied continuously in a pattern such as stripes.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to do so motivated by the fact that Von Kohorn et al., also drawn to methods for the formation of a sheet material containing an active substance capable of diffusing through the

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sheet material, disclose that it is known that an active substance may be applied continuously in a pattern such as stripes, dots, etc (column 11, lines 10-13).

Senninger, as combined in section (1), above, discloses that the active material may be pyrethrum. Although they do not specifically disclose the active materials set forth in applicant claims 12 and 14, it would have been obvious to one of ordinary skill in the art at the time of invention to use these materials motivated by the fact that Von Kohorn et al., also drawn to methods for the formation of a sheet material containing an active substance capable of diffusing through the sheet material, disclose that it is known to utilize As per applicant claim 12, Von a pheromone attractant such as 9,12 tetradecadienyl acetate (column 19, table II) or, as per applicant claim 14, dimethoate (column 20, line 66).

(3)

***Allowable Subject Matter***

Claims 3 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Although Senninger discloses that the active substance may be applied by spraying, printing or any suitable method (page 1, column 2, lines 106-12), neither they nor any of the prior art of record specifically teach or suggest the pressure parameters set forth in applicant claims 3 and 16.

(4)

***Response to Arguments***

The amendments filed October 14, 2003 are acknowledged. In response to the arguments set forth therein, the grounds of rejection, as set forth in section (1), above, has been modified to address such arguments. The applicant's remaining arguments have likewise been fully considered but are not found persuasive. Although the applicant argues that the claimed viscosity is not shown by the references as combined, the examiner submits that the use of a solvent to modify the viscosity, as disclosed by Bagdachi et al., illustrates the obvious step of modifying rheological properties of a liquid via solvents which is also ultimately dependent upon the means and methods of applying the material to a substrate.

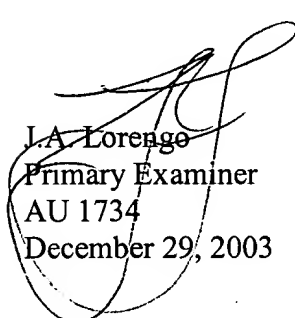
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(5)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. Please note that all patent application related correspondence transmitted by FAX must be directed to the central FAX number at 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



J.A. Lorengo  
Primary Examiner  
AU 1734  
December 29, 2003